

## **REMARKS**

### **I. Introduction**

In response to the pending rejection, Applicants have amended claim 1 so as to incorporate the elements set forth in claim 2, which has been cancelled. In addition, Fig. 4 has been amended to include the legend "Prior Art".

Applicants respectfully submit that all pending claims are patentable over the cited prior art for the reasons set forth below.

### **II. The Rejection Of Claims 1-5 And 8 Under 35 U.S.C. § 103**

Claims 1-5 and 8 were rejected under 35 U.S.C. § 103 as being unpatentable over USP Pub. No. 2003/0030618 to Jones in view of USP No. 6,476,822 to Burbank. Applicants respectfully submit that the foregoing claims are not rendered obvious by the cited prior art.

#### ***A. All Limitations Are Not Disclosed By The Prior Art***

Even assuming *arguendo* that the combination of Jones and Burbank is proper, as explained below, the combination still fails to disclose or suggest each of the limitations set forth in the amended claims and therefore does not present a *prime facie* case of obviousness.

As recited by amended claim 1, the present invention relates to an image display device comprising in-part a control device which determines whether the image data stored in a first storage device is dynamic or static, and, in the case of a static image, after storing the signals corresponding to one frame of the image data in the second

storage device, operates only the second storage device, the display drive device and the image display device. Furthermore, claim 1 also recites that the second storage device has a smaller memory capacity than the first storage device.

As a result of the foregoing structure and operation, the present invention reduces the power consumption associated with displaying a static image by both reducing the memory capacity of the second storage device that stores the static image represented by the reduced number of bits, and by minimizing the number of components to be operated for displaying the static image.

Turning to the cited prior art, it is admitted in the pending rejection that Jones fails to disclose or suggest the use of a second memory for storing the static image represented by a reduced number of bits. Burbank is relied upon as curing this deficiency of Jones. However, for the following reasons, it is clear that this conclusion is incorrect.

Burbank discloses a system which relates to a display apparatus that can switch between the display of a dynamic image and a static image, where the static image is stored in a second memory area by a static image driver. Importantly, however, the static image that is stored in the second memory area is an **enhanced static** color image (see, e.g., Abstract). The enhanced static color image requires more data and therefore more storage capabilities within the device, as compared to that required for storing an ordinary static image. Thus, the second storage device of Burbank requires a larger storage capacity than that required to store an ordinary static image.

Thus, Burbank also fails to disclose or suggest the use of a second memory for storing the static image represented by a reduced number of bits, wherein the memory

capacity of the second storage device is less than the memory capacity of the first storage device.

Accordingly, for at least the foregoing reasons, it is respectfully submitted that even assuming *arguendo* that the combination of Jones and Burbank is proper, the combination thereof fails to disclose each and every limitation recited by the rejected claims. As a result, the combination of the cited prior art cannot be utilized to properly reject claim 1 or any claim dependent thereon.

***B. No Motivation To Combine The References***

It is also respectfully submitted that there is no motivation to combine Jones and Burbank in the manner set forth in the pending rejection. Specifically, the pending rejection asserts that Burbank discloses the use of the second storage device for storing one frame of image data when the image is determined to be static as opposed to dynamic, and that Jones can be modified to utilize this second storage device of Burbank. However, Burbank discloses a system which relates to a method of displaying ***enhanced static*** color images. The enhanced static color images require more data and therefore more storage capabilities within the device. The second storage device of Burbank is utilized to store the data for the enhanced static image. Jones has no such enhanced static image. Nor does Jones express a need for displaying such an enhanced static image. Jones' device is concerned with determining whether to display a static or dynamic image, while Burbank relates to a device for displaying enhanced static images. Thus, one of skill in the art would not be motivated to modify the teaching of Jones in view of Burbank. Accordingly, there is no motivation or reason to combine

the teachings of Jones with Burbank absent reference to the Applicants' specification, which is impermissible. Indeed, contrary to the basis set forth in the rejection for combining the references, if Jones is modified in accordance with the teaching of Burbank, the resulting device would exhibit an increase in power consumption, not a decrease. As such, it is respectfully submitted that the rejection is in error, and does not establish a *prima facie* case of obviousness, as there is no motivation to make the proposed modification.

Further, the Examiner is directed to MPEP § 2143.01 under the subsection entitled "Fact that References Can Be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

In the instant case, even assuming *arguendo* that Jones can be modified by Burbank, it is submitted that the "mere fact that [the patents] can be combined ... does not render the resultant combination obvious" because nowhere does the prior art "suggest the desirability of the combination" as set forth by the Examiner. Indeed, as noted above, the motivation for the combination set forth in the Office Action (i.e., reduced power consumption) is not obtained by the combination. Thus, there is no valid basis or objective evidence referenced in the pending rejection in support of the proposed modification.

For all of the foregoing reasons, it is respectfully submitted that the pending claims are patentable over Jones and Burbank, taken alone, or in combination with one another.

III. **All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987).

Accordingly, as claim 1 is are patentable for the reasons set forth above, it is respectfully submitted that all dependent claims are also in condition for allowance.

IV. **Request For Notice Of Allowance**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of

this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such Deposit Account.

Respectfully submitted,

McDERMOTT, WILL & EMERY

Date: 2/23/24

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